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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE PATENT	: EXAMINER: MEI, XU
MASAYUKI NISHIGUCHI, ET AL.	: GROUP ART UNIT: 2644
PATENT NO: 6,445,800	: ISSUED: SEPTEMBER 3, 2002
SERIAL NO: 09/489,774	: FILED: JANUARY 24, 2000
FOR: AUDIO SIGNAL REPRODUCING APPARATUS	

PETITION UNDER 37 C.F.R. § 1.181(A)(2)

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The Assignee, Sony Corporation, through its patent counsel hereby petitions the Director to nullify any effect the terminal disclaimer filed on June 13, 1994 in U.S. Patent No. 5,640,458 (the '458 Patent) has on the above-identified patent, which claims the benefit of the filing date of the '458 Patent. This petition is made consistent with 37 C.F.R. § 1.182, which states:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing.

STATEMENT OF RELATED PETITIONS

This petition is related to similar petitions filed in U.S. Patent No. 5,640,458; U.S. Patent No. 5,930,758; U.S. Patent No. 6,695,477; U.S. Patent No. 6,975,732; U.S. Patent No. 7,330,553; and U.S. Patent No. 7,337,027.

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STATEMENT OF FACTS

Patentee filed U.S. Application Serial No. 09/489,774 on January 24, 2000. During the course of prosecution, Patentee filed a terminal disclaimer on March 29, 2002 in this application which disclaims the terminal part of any patent that issues from U.S. Application Serial No. 09/489,774 that extends beyond the term of the '458 Patent. This application issued as Patent No. 6,445,800 (the '800 Patent) on September 3, 2002. Because U.S. Application Serial No. 09/489,774 is a divisional of U.S. Application Serial No. 08/747,910, which is a divisional of the '458 Patent, the '800 Patent is entitled to claim the benefit of the filing date of the '458 Patent. The relevant facts surrounding the prosecution of Application Serial No. 07/600,818 (which issued as the '458 Patent) are provided next.

Patentee filed U.S. Application Serial No. 07/600,818 on October 22, 1990, and prosecuted this application until it issued as the '458 Patent on June 17, 1997. During the course of prosecution, the U.S. Patent and Trademark Office (the "Office") incorrectly mailed a non-final Office Action on January 23, 1992 to an incorrect address. Thus, Applicants' then representative never received the Office Action, ultimately causing the Office to mail a Notice of Abandonment to Patentee's then representative on August 25, 1992.

The next entry in the record of the '458 Patent is an Interview Summary of an interview held on January 13, 1994, indicating that Patentee's then representative received no communication from the Office regarding Application Serial No. 07/600,818 for "several years." For reasons unexplained, the Interview Summary indicates Patentee's then

representative would file a Petition to Revive under 37 C.F.R. §1.137(a) and would file the terminal disclaimer of June 13, 1994, as required by this rule.

The terminal disclaimer filed on June 13, 1994 in U.S. Application Serial No. 07/600,818 not only disclaimed the terminal 26 months of any patent that issued from this application, it also disclaimed the terminal 26 months of any application "which is entitled to the benefit of the filing date of [the U.S. Application Serial No. 07/600,818] under 35 U.S.C. § 120."

During later stages of prosecution, another terminal disclaimer was filed on September 13, 1995 that disclaimed the part of any patent to issue from Application Serial No. 07/600,818, which extended beyond the expiration of U.S. Patent No. 5,241,603.

Application Serial No. 07/600,818 issued as Patent No. 5,640,458 (the '458 Patent) on June 17, 1997.

ACTIONS REQUESTED

Initially, Patentee respectfully request that 37 C.F.R. §1.182(f) be suspended. Rule 182(f) indicates that a petition not filed within two months of the action or notice from which relief is sought may be dismissed as untimely. However, under 37 C.F.R. §1.183, the Director, or the Director's designee, may suspend or waive a Rule in the event of extraordinary circumstances or when justice requires. Patentee submits that the present situation is such a case.

Here, Patentee does not ask to extend the term of U.S. Patent No. 6,445,800. Rather Patentee merely asks that the *original, statutory term* of this patent be restored. Consistent with all the duties imposed on Applicants by Title 35 of the U.S. Code, Patentee constructively reduced the invention to practice by filing an application and then prosecuted Application Serial No. 09/489,774, which eventually issued as the '800 Patent.

However, nearly four years earlier, the Office failed in its duty to notify Applicants of an Office Action regarding U.S. Application Serial No. 07/600,818, ultimately causing the Office to issue a Notice of Abandonment in that application. Moreover, the 26 month delay in the prosecution of U.S. Application Serial No. 07/600,818 resulted only because the Office sent the Office Action of January 23, 1992 to the wrong address. In an effort to correct the USPTO's error in Application Serial No. 07/600,818, Patentee's then representative took the extraordinary step of filing a terminal disclaimer under 37 C.F.R. §1.137, which was a requirement under the Law at this time, when the term for patents expired 17 years from the issue date. Now that terminal disclaimer, which disclaims the terminal 26 months of any patent that issues from any application that is entitled to claim the benefit of U.S. Application Serial No. 07/600,818, potentially cuts short the terms of an entire patent family, of which the '800 Patent is a part, and causes confusion as to the proper expiration date of these patents.

As a result of the Office's error in the parent application, the resulting confusion, and subsequent change in law that changed patent terms from 17 years from issue to 20 years from earliest priority date, Patentee has been unjustly denied the full 20 years entitled to U.S. Patent No. 6,445,800. Therefore, Patentee respectfully asks that 37 C.F.R. §1.182(f) be waived so that this Petition may be decided on the merits.

Patentee also requests that the terminal disclaimer filed on June 13,1994 be given no effect in the '800 Patent either directly or through its application to the '458 Patent, and, as discussed below, finds that the present situation does not fall under any current rule.

First, Patentee notes that the terminal disclaimer of June 13, 1994 filed in the '458 Patent creates an ambiguity as to the proper expiration date, both the '458 Patent and the '800 Patent. Regarding the '458 Patent, if the two disclaimers in the '458 Patent are construed so that the one which shortens the patent term the most controls, then the terminal disclaimer filed on September 13, 1995 would control, and the terminal disclaimer filed on

June 13, 1994 would have no effect. However, if the disclaimers are construed to sequentially restrict the patent term, the patent term of the '458 Patent may be construed to end on the date of expiration of U.S. Patent No. 5,241,603 (as a result of the terminal disclaimer of September 13, 1995) less 26 months (as a result of the terminal disclaimer of June 13, 1994.)

In the case of the '800 Patent, there is even greater uncertainty in the proper expiration date. First, because a terminal disclaimer was filed in the '800 Patent on March 29, 2002 that links the '800 Patent to the '458 Patent, the ambiguities in the proper expiration date of the '458 Patent are directly transferred to the '800 Patent. However, because the '800 Patent is a divisional of the '458 Patent, the June 13, 1994 terminal disclaimer in the '458 Patent also directly applies to the '800 Patent. Thus, an ambiguity as to the proper expiration date of the '800 Patent also arises from the interaction of the June 13, 1994 terminal disclaimer and the March 29, 2002 terminal disclaimer in the same way as described above for the '458 Patent. Therefore, Patentee respectfully requests that the Director, consistent with his power under 37 C.F.R. §1.182, nullify any effect that the terminal disclaimer of June 13, 1994, filed in the '458 Patent, may have on the '800 Patent in order to resolve the ambiguity in the proper expiration date of the '800 Patent.

In support, Patentee notes that a similar situation arose in *Bayer AG v. Carlsbad Technology, Inc.*, 298 F. 3d 1377 (2002). There, the patentee, Bayer, filed a terminal disclaimer that disclaimed "the earlier of the expiration dates of U.S. Patent Nos. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985.) *Bayer* 298 F. 3d 1377, 1378. Then in 1994, the URAA "harmonized the term provision of the United States patent law with that of our leading trading partners which grant a patent term of 20 years from the date of filing of the patent application." *Id.* In view of this, Bayer sought to amend the

terminal disclaimer to reflect a later expiration date of December 9, 2003 instead of the expiration date of October 1, 2002 (as a result of the originally-worded disclaimer.)

In that case Bayer sought to amend the terminal disclaimer to increase the patent term under 37 C.F.R. §1.182 and the Office agreed stating:

> In view of the ambiguity in the terminal disclaimer filed February 21, 1992 created by the changes to 35 U.S.C. § 154 (c)(1) contained in Public Law 103-465, Office records will be changed to indicate that the term of the [Bayer patent] *will be changed to the later* of the two (2) dates set forth in the terminal disclaimer... (*Id.* at 1379, quoting 64 USPQ 2d 1045.) (Emphasis added.)

Both the Federal District Court and the Federal Appeals Court for the Federal Circuit agreed with the Office.

Like *Bayer*, the term for the '800 Patent contains an ambiguity as to its date of expiration. In *Bayer* the ambiguity arose out of circumstances beyond the Patentee's control: the URAA. Here the ambiguity arose beyond the Patentee's control: the far-reaching effects of the Office's error in mailing an Office Action concerning another application to the wrong address. Unlike *Bayer*, however, here Patentee does not seek to increase the term of the '800 Patent, but only to restore it to its original length and to make its expiration date certain by resolving the ambiguity. Thus, the present Petition does not even request as much relief as that granted in *Bayer*. Therefore, the ambiguity should be resolved in favor of the patentee, and this can only be accomplished by nullifying any effect on the '800 Patent of the terminal disclaimer of June 13, 1994 filed in the '458 Patent .

Further, patentee notes that the recapture principle stated in M.P.E.P. §1490 VII B does not apply here. The recapture principle is a principle against recapturing something that has been *intentionally* dedicated to the public, and is most notably expressed in *Leggett v. Avery*, 101 U.S. 256 (1879). However, unlike the present case, in *Leggett* the patentee was seeking an extension to his patent's term. Here, Patentee merely seeks the original term that the '800 Patent would have, had the first Office Action not been mailed to the wrong address

during the prosecution of the '458 Patent. Moreover, in *Leggett*, the patentee *voluntarily* filed the terminal disclaimer to obtain the patent extension. In the present case, Patentee did not even file the offending terminal disclaimer in the '800 Patent. The terminal disclaimer of June 13, 1994 only applies as a result of the far-reaching effect of the Office's mistake. Thus, it is submitted that the present case does not fall within the bounds of *Leggett* and that the principle against recapture does not apply.

M.P.E.P. §1490 also states:

> Where applicants did not challenge the propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. §251. *Ex parte Anthony*, 230 USPQ 467.

The present case, however, does not fall within the above-quoted passage. First, here Patentee does not seek reissue under 35 U.S.C. §251, a Certificate of Correction under 35 U.S.C. § 255 or reexamination under 35 U.S.C. § 305. *Ex parte Anthony* dealt with a reissue. Second, Patentee did not file the terminal disclaimer of June 13, 1994 in the '800 Patent. Therefore, Patentee had no opportunity to challenge the propriety in giving this terminal disclaimer effect over the '800 Patent. Instead the '800 Patent, as a result of the Office's error and Patentee's then representative's attempts to remedy the error, contained a terminal disclaimer before its application was even filed. Lastly, Patentee here seeks only to have the *original* term of the '800 Patent reinstated and clarified by removing any ambiguity as to this patent's proper expiration date. Thus, M.P.E.P. §1490 does not apply to the present case.

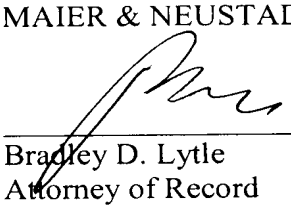
Even if the Director reaches a different conclusion than that outlined above, the balance of equities favor nullifying any effect the June 13, 2008 terminal disclaimer from the '458 Patent might have on the '800 Patent. Patentee was merely trying to obtain a patent, and complied with all applicable Laws and Rules in submitting an application for Letters Patent. Patentee did so believing that Patentee would be entitled to a full patent term under which to

recover Patentee's investment in the invention. Patentee would have received the full patent term in the '800 Patent but for the far-reaching effects of a mailing error by the Office in another application that ultimately caused U.S. Application Serial No. 07/600,818 to go abandoned for a period of 26 months during which Patentee's then representative stated, on the record, that he "received no communication" from the Office. This error not only resulted in the shortening of the '458 Patent by 26 months, it also rendered the proper expiration date of the '800 Patent completely uncertain. Thus, Patentee only asks for correction of the error by restoration of the *original* term of the '800 Patent.

For the reasons discussed above, Patentee respectfully requests that the terminal disclaimer filed on June 13, 2008 in U.S. Patent No. 5,640,458 be given no effect in U.S. Patent No. 6,445,800, nor any other patent that may claim the benefit of U.S. Patent No. 5,640,458 under 35 U.S.C. §120.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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